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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,601	08/31/2001	Kia Silverbrook	AP72US	7470
24011	7590	12/11/2003	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			KIM, PETER B	
			ART UNIT	PAPER NUMBER
			2851	

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

**Application No.**

09/942,601

**Applicant(s)**

SILVERBROOK, KIA

**Examiner**

Peter B. Kim

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. 09/436,750.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's arguments filed on Oct. 5, 2003 have been fully considered.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The written description does not include adequate support for feed mechanism that is engageable with a lowermost sheet of media in the cartridge.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobry (6,229,565).

Bobry discloses an apparatus for recording and generating images (Fig. 1) comprising: a printing unit (26) that comprises a carrier (Fig. 3), a page width print head (30), an ink supply (30), a media cartridge for holding a roll of media (28), a media feed mechanism (col. 5, lines

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25-43), a housing (col. 4, lines 35-40), an image sensing device (14) with an microprocessor with data bus connected across the image sensing device, the microprocessor and the image recordal apparatus (Fig. 7) to control the operation of the image sensing device and communicating with the printing unit (col. 7, lines 15-67). Bobry also discloses carrier that is substantially rectangular (Fig. 1 and 3) with the print head and the ink supply mounted on an end portion and the media feed mechanism at intermediate the end portion and a remaining portion (Fig. 1). Although Bobry does not disclose the carrier that is dimensioned to a PCMCIA card and sheets of media, it would have been obvious to one of ordinary skill in the art at the time of the invention to decrease the size of the camera and the printing unit including the carrier to the smallest possible size because it is well known in the art that smaller size is desired for convenience of easy handling and carrying. It would also have been obvious to one of ordinary skill in the art to provide cut sheets of media instead of the roll because unlike a roll, with the cut sheets the cutting means is not needed, and having one less structure helps decreasing the size of the carrier which is desirable in the art for the reasons of convenience.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bobry as applied to claim1 above, and further in view of Hawkins et al. (Hawkins) (6,154,254).

The further difference between the modified Bobry and the claimed invention is the CMOS device that is the image sensing device. Hawkins discloses in the abstract and in col. 3, lines 31-53, an image capture and printing system with image sensor that is a CMOS device. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to further modify the invention of Bobry with the CMOS device of Hawkins in order to transfer

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in parallel to the printing device electron charges or voltage signal from the sensor as taught by Hawkins in col. 3, lines 35-40.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bobry as applied to claim 1 above, and further in view of Kokubo (6,007,195).

The further difference between the modified Bobry and the claimed invention is the PCMCIA-type connectors. Kokubo discloses a detachable scanning printer with a PCMCIA interface (Fig. 1) with at least half the carrier, which is dimensioned to approximate a PCMCIA memory card, is received in the housing (Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide the scanning printer unit of Kokubo to the invention of McIntyre in order to provide an interface between the camera and the printer unit as taught by Kokubo in col. 1, lines 40-61 to provide more effective communication between the printer and the camera.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-4, 6, 7, and 8 have been considered but are moot in view of the new ground(s) of rejection.

Regarding Claim 5, applicant argues that Fig. 3, ref. 38, the primary feed roller "would be understood by one of ordinary skill in the art to correspond to the feature described in claim 5." The examiner respectfully disagrees. It would be understood by one of ordinary skill in the art that the feed roller would be engageable with the top most sheet of media as in typical printing devices since the top most sheet is clearly more accessible than the lower most sheet. Fig. 3 does

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not adequately disclose to one skilled in the art to use the invention where the feed mechanism is engageable with the lower most sheet of media.

Regarding Kokubo reference, applicant argues that the laptop in Kokubo is not an image recordal apparatus; however, Kokubo is relied on only to the extent that PCMICIA interface which provides more effective communication between the two devices computer-printer or camera-printer.

Due to new grounds of rejection the current office action is made non-final.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Kim whose telephone number is (703) 305-0105. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays during the same hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams, can be reached on (703) 308-2847. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Peter B. Kim  
Patent Examiner  
November 16, 2003